



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/582,192

02/12/2007

Adrian Blair Gardiner

1209.75321

2192

24978 7590 05/28/2010

GREER, BURNS & CRAIN
300 S WACKER DR
25TH FLOOR
CHICAGO, IL 60606

EXAMINER

NICONOVICH, ALEXANDER R

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

05/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,192	Applicant(s) GARDINER, ADRIAN BLAIR	
	Examiner ALEXANDER R. NICONOVICH	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-60 is/are pending in the application.
- 4a) Of the above claim(s) 50-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-49, 59 and 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. In an amendment filed 4/15/10, applicant has withdrawn claims 50-57 and added a new claim 58. The amendment is acknowledged. Claims 14-49 and 59-60 remain pending.

Claim Warnings

2. Applicant is advised that should claim 14 be found allowable, claim 60 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-49 and 59-60 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See

Art Unit: 3711

Diamond v. Diehr, 450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing *en banc* pending). The current claims fail to require that 1) the method be implemented by a particular machine (the method is not implemented by a machine, it is simply played on the court and further, playing court is not a particular machine (a concrete thing consisting of parts)) and 2) the method particularly transform a particular article (there is no transformation of an article in the claims). *In re Bilski*.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 14-20, 22, 24, 27-29, 31, 33-38, 41, 43-49, and 59-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Wikipedia ("Fencing" 6/31/06).

Wikipedia¹ teaches:

In Reference to Claims 14 and 60

A method of playing a team combat sport (team fencing, "Team events" page 12) wherein: each team combats one another to achieve an

Art Unit: 3711

objective (strike opponent); the teams combat each other within a predetermined game area (piste, page 6) using at least one hand-to-hand weapon (swords: foil, epee, and sabre, pages 3-5) to achieve the objective of hitting out an opposing player by using the weapon to strike a pressure pad in a target area on an opposing player until all the opposing team players are hit out ('Electronic scoring equipment', pages 8-10); the play further including: a single player may challenge or be challenged by one or more opponents in a single game (players from each team challenge each other); and the game area comprises at least two physical playing regions including a first playing region having one or more defined game play areas and a second larger playing region defining a further game play area (players begin inside two meters from the midpoint (en-garde lines) and may later move along the remainder of the piste; page 6).

In Reference to Claim 15

A method as claimed in claim 14 as rejected above and wherein the objective is to hit out a key player or key players on the opposing team (player currently playing).

In Reference to Claim 16

A method as claimed in claim 14 as rejected above and wherein the objective is to hit out all of the players on the opposing team (points rewarded for hitting out players, most points win).

In Reference to Claim 17

A method as claimed in claim 14 as rejected above and wherein players aim to hit a target area on an opposing player wherein the target area is selected from: the whole body; the head; the torso; the upper body; the arms; the legs; the lower body; the groin; the back; at least one shoulder; a pressure pad or pads; and combinations thereof (different target areas for different weapons, pages 4-5. Electronic equipment pages 8-10).

In Reference to Claim 18

A method as claimed in claim 14 as rejected above and wherein multiple rounds are played, each round being complete once the objective is achieved (multiple rounds, rounds end once the amount of points are achieved, "Team events" page 12).

In Reference to Claim 19

A method as claimed in claim 18 as rejected above and wherein after each round, players in each team rotate position and a new player or players become the key player or players (players rotate each round, "Team events" page 12).

In Reference to Claim 20

Art Unit: 3711

A method as claimed in claim 14 as rejected above and wherein the combat is scored using methods selected from the group consisting of: the team that achieves the objective scores a point or points (legal hits are points); the team that wins the highest number rounds is the winner wherein each objective achieved is counted as one round (first team to win 5 matches wins, each rounds counts as a point, page 13); the team that wins the highest number of rounds after a set period of time where as many rounds as fit into that time period are completed and wherein each objective achieved is counted as one round; and combinations thereof ("Team events" page 12-13).

In Reference to Claim 22

A method as claimed in claim 14 as rejected above and wherein if a player is hit out, that player remains idle (round is over, but player can play next round).

In Reference to Claim 24

A method as claimed in claim 14 as rejected above and wherein if a player is hit incorrectly or unfairly they may continue to participate in the combat (only legal hits count as points).

In Reference to Claim 27

Art Unit: 3711

A method as claimed in claim 14 as rejected above and wherein pressure pads are used for registering hits, located on or approximate to key target areas on the player including the head, shoulders and chest (scoring areas, pages 4-5, electronic equipment pages 8-10).

In Reference to Claim 28

A method as claimed in claim 27 as rejected above and wherein, when a pressure point is hit, a visual and/or audio cue is emitted (lights signal touches, page 9).

In Reference to Claim 29

A method as claimed in claim 14 as rejected above and wherein each team includes at least three players (3 per team, page 12).

In Reference to Claim 31

A method as claimed in claim 14 as rejected above and wherein each team includes at least one forward player, at least one back player and at least one key player (teams consist of three players, one of which can be a "forward player", one a "back player", and one a "key player"). Further, any player can be designated as forward, back, or key players since there is no further limiting feature that distinguishes the player titles.

In Reference to Claim 33

A method as claimed in claim 31 as rejected above and wherein the movement of each player is defined by their designation selected from: forward player, back player, key player (each player is restricted to the piste).

In Reference to Claim 34

A method as claimed in claim 31 as rejected above and wherein forward players may initially move only within a restricted area within the game area (all players can only move within piste aisle, page 6).

In Reference to Claim 35

A method as claimed in claim 34 as rejected above and wherein the restricted area is a lane approximately 10 meters long and 1 meter wide (Page 6).

In Reference to Claim 36

A method as claimed in claim 34 as rejected above and wherein, if a forward player steps out of the restricted area before they hit out their opponent, then they are hit out themselves (point given when other player goes beyond the back edge of the game area, page 8).

In Reference to Claim 37

A method as claimed in claim 34 as rejected above and wherein, once a forward player hits out their opposing forward player, they can then move out of the restricted area (once a player strike another the round is over and they can move outside the piste).

In Reference to Claim 38

A method as claimed in claim 31 as rejected above and wherein back players may move any where within the game area however they must start at a predetermined fixed point within the game area (all players start at the same spot, after which they can move within the piste area).

In Reference to Claim 41

A method as claimed in claim 14 as rejected above and wherein an automatic hit out occurs on any player if that player steps outside of the overall game area at any point of the game (point given when other player goes beyond the back edge of the game area, page 8).

In Reference to Claim 43

A method as claimed in claim 14 as rejected above and wherein hits are judged visually (non-electronic scoring, page 10).

In Reference to Claim 44

A method as claimed in claim 14 wherein at least one umpire is used who is responsible for a respective area of play (1-4 referees, pages 6, 10).

In Reference to Claim 45

A method as claimed in claim 15 as rejected above and wherein umpires are used to control the combat and include a central umpire (president referee, page 7) and key player umpires assigned to each key player (each player has referees assigned to them, page 6).

In Reference to Claim 46

A method as claimed in claim 45 as rejected above and wherein the central umpire oversees combat associated between any players not directly connected with a key player (president referee oversees all action, page 7).

In Reference to Claim 47

A method as claimed in claim 45 as rejected above and wherein the key player umpires are responsible for judging combat around each key player (side judge for each player, pages 6-7).

In Reference to Claim 48

A method as claimed in claim 45 as rejected above and wherein one key player umpire becomes senior to the other when both key players are caught up in the same action (president referee, page 7).

In Reference to Claim 49

A method as claimed in claim 44 as rejected above and wherein umpires are positioned along side lines of the game area (pages 6, 10).

In Reference to Claim 59

A method of playing a team combat sport, as claimed in claim 14 as rejected above and further characterized in that individual player restrictions imposed by the game area are redefined during play based on the outcome of the team combat (penalty for putting feet off the side edge of the piste results in the opponent advancing one meter towards the penalized fencer; Penalties, Page 8).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21, 23, 25-26, 30, 32, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wikipedia1 ("Fencing", 6/31/06) as applied to claim 14 above and further in view of Wikipedia2 ("Dodgeball", 1/20/07).

In Reference to Claim 21

Wikipedia1 teaches:

A method as claimed in claim 14 as rejected above.

Wikipedia1 fails to teach:

When a player is hit out by an opponent, they may not participate further.

Wikipedia2 teaches:

A similar combative team sport method wherein if players are hit they are eliminated from the game (page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the playing method of Wikipedia1 so that if a player was struck or hit they would be eliminated as taught by Wikipedia2 as an alternate way of scoring the team event (team with last player standing wins) to make the game more exciting and entertaining. Also, sudden death type matches are known in the art (Wikipedia1: direct elimination format, page 13).

In Reference to Claim 23

Wikipedia1 teaches:

Art Unit: 3711

A method as claimed in claim 14 as rejected above.

Wikipedia1 fails to teach:

Wherein if a player is hit out, that player can participate again in combat after a predetermined period of time has elapsed.

Wikipedia2 teaches:

A similar combative team sport method wherein if players catch a ball, a player from the catching team may re-enter the game (page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the playing method of Wikipedia1 to have allowed players to return to the game making the game more exciting and fun.

In Reference to Claims 25-26

Wikipedia1 teaches:

A method as claimed in claim 14 as rejected above.

Wikipedia1 fails to teach:

Wherein if a player is hit by a fellow team member, or hit by themselves, then the player hit is then hit out.

Wikipedia2 teaches:

Art Unit: 3711

A similar combative team sport method wherein if players are hit by a live ball (any ball released by a player and not yet hit the ground or has been deflected) they are eliminated from the game (page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the playing method of Wikipedia1 to have allowed any player to be eliminated by their own teams fault to make the game more fun and entertaining.

In Reference to Claim 30

Wikipedia1 teaches:

A method as claimed in claim 14 as rejected above.

Wikipedia1 fails to teach:

Wherein each team includes at least six players.

Wikipedia2 teaches:

A similar combative team sport method wherein if players are hit they are eliminated from the game (page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the playing method of Wikipedia1 to have allowed each team 6 players to allow the match to go on longer and give more players the chance to play.

In Reference to Claim 32

Wikipedia1 teaches:

A method as claimed in claim 14 as rejected above.

Wikipedia1 fails to teach:

Wherein each team includes three forward players, two back players and one key player (6 players).

Wikipedia2 teaches:

A similar combative team sport method wherein if players are hit they are eliminated from the game (page 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the playing method of Wikipedia1 to have allowed each team 6 players to allow the match to go on longer and give more players the chance to play. Further, once each team has 6 players, any player can be designated as forward, back, or key players since there is no further limiting feature that distinguishes the player titles.

In Reference to Claim 40

Wikipedia1 teaches:

A method as claimed in claim 31 as rejected above.

Wikipedia1 fails to teach:

Wherein back players and the key player or key players move together as a unit unless both back players are hit out in which case the key player may move independently of the back players (Peek-a-boo strategy).

Wikipedia2 teaches:

A similar combative team sport method wherein two players work together to achieve a goal (Peek-a-boo strategy).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the playing method of Wikipedia1 to have allowed players to work together to allow the match to more variety and entertainment and enhance teamwork as taught by Wikipedia2.

9. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wikipedia1 ("Fencing" 6/31/06) as applied to claim 14 above and further in view of Lohre US Pat. No. 4,892,303.

In Reference to Claim 42

Wikipedia1 teaches

A method as claimed in claim 14 as rejected above and wherein the weapon is a sword with a handle section and a blade section (foil, epee, sabre, pages 4-5) including: (a) a central core common to both the handle

and blade sections; (c) defined blade edges on the blade section (triangular blade, page 5); (d) a blade cutting edge that is curved along the length of the blade section (sabre has slightly curved blade, page 5).

Wikipedia1 fails to teach:

The sword having a rounded cutting edge on the blade section, and the cutting edge having a separate outer layer material.

Lohre teaches:

A safety fencing sword that has a rounded blade and has a softer outer blade layer (Fig. 1-2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the sword used in the game of Wikipedia1 so that the sword was safer and reduced injuries as taught by Lohre (Col. 1 lines 27-32).

Response to Arguments

10. Applicant's arguments filed 4/15/10 have been fully considered but they are not persuasive. As noted in the rejection above, the piste teaches more than one playing area including: 1) the en-garde area marked by lines (2 meters from each side of the midpoint) which is the area where the players begin the match, 2) the warning area of the piste marked by lines (2 meters from the end of both sides of the piste) as well as 3) the standard piste which is traveled during game play. Further, the 101 rejection of all

Art Unit: 3711

the pending claims has not been overcome as the current claims fail to require that 1) the method be implemented by a particular machine (the method is not implemented by a machine, it is simply played on the court and further, playing court is not a particular machine (a concrete thing consisting of parts)) and 2) the method particularly transform a particular article (there is no transformation of an article in the claims).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the references cited page for publications that are noted for containing similar subject matter as the applicant.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3711

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER R. NICONOVICH whose telephone number is (571)270-7419. The examiner can normally be reached on M-F 7:30 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. R. N./
Examiner, Art Unit 3711
/Gene Kim/
Supervisory Patent Examiner, Art Unit 3711